

REMARKS

Phone Conferences

Applicants wish to thank the Examiner for his time in discussing the status of the case on June 24, 2010, where it was clarified that this Action is a Non-Final Action as noted on the Office Action Summary, and NOT a Final Action as per the language in the Action paragraph 15 on page 9.

Additionally Applicants thank the Examiner for his time in reviewing and discussing proposed draft claim amendments on September 15, 2010.

Status of the Claims

Claims 1-4, 9 and 10 are pending and all currently amended. Claims 5-8 and 11-13 are cancelled. No new matter is added by the claim amendments; support is found throughout the specification as filed, including the originally filed claims. For example, in claim 1: support for the holding device can be found in paragraphs [0055] and [0062], support for the gripper can be found in paragraph [0051], and support for the rotating mechanism can be found in paragraphs [0037] and [0051]. Support for the insertion slopes of claim 2 can be found for example in paragraph [0042]. Support for the location of the projections of claims 9 and 10 can be found for example in paragraphs [0056] and [0057].

Applicants respectfully request entry of the present claim amendments.

Claim Objections

The Examiner has objected to claim 10 due to the incorrect status identifier on the Applicant's previous submissions. (Action page 2)

Applicants have presently amended claim 10 and now correctly identify this claim as "presently amended". Applicants respectfully request the withdrawal of the objection.

Claim Interpretations and Claim Rejections under 35 U.S.C. § 112 second paragraph

The Examiner asserts that language in claims 1, 5 and 6 does not positively set forth the claimed subject matter and/or distinguish the claimed apparatus from the prior art. (Action page 2) Further, the Examiner has rejected claims 1-11 under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Action pages 3-5)

To address the Examiner's concerns and rejections, solely to facilitate prosecution and without acquiescence in the rejections, Applicants have presently amended claims 1-4, 9 and 10, and cancelled claims 5 and 6. Applicants have amended much of the language of claim 1 to clarify the language describing the claimed apparatus. For example, the language of claim 1 now specifically identifies 3 structurally defined components comprising: a holding device, a gripper and a rotating mechanism, each component further defined by specific structures. Further for example, the "one or more reaction vessels" and a "lid of one of the reaction vessels" are now clearly part of the claimed subject matter in claim 1.

Applicants respectfully request withdrawal of the 112 rejections.

Claim Rejections under 35 U.S.C. § 102(b)

The Examiner has rejected claims 1-5 under § 102(b) as being anticipated by Burt et al. (Action pages 5-6). The Examiner asserts, in part, that Burt discloses a device in figures 1-6 comprising the instant invention.

Solely to facilitate prosecution and without acquiescence in the rejections, Applicants have presently amended claims 1-4, 9 and 10. Applicants assert that Burt does not disclose each and every limitation of the instant invention. The Examiner has not established that the device of Burt can open and close the lid of the reaction vessel, as required by the instant invention. The Examiner has not identified any disclosure in Burt's teaching that the device can be used to close the lid of the reaction vessel. In contrary, Burt teaches "FIG 6, the hollow, cup shaped device 74 is provided with means 96 for knocking out any cap remaining in the hollow, cup shaped device 74 after a measurement has been made". (Burt column 3 lines 6-63) This clearly shows that the device of Burt is intended only to remove a cap, and not to replace the cap on the vessel because the cap is knocked out of the way.

Because an asserted §102 reference must contain all limitations of a claim to anticipate that claim, Burt cannot be cited as anticipating claim 1. The other rejected claims depend from claim 1 and, therefore, also cannot be rejected based on Burt.

Therefore, Applicants respectfully request reconsideration and withdrawal of all §102 rejections based on Burt.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 6-11 under § 103(a) as being unpatentable over Burt et al. in view of Marino. (Action page 6) The Examiner asserts, in part, that in regards to claims 6-8 and 11 Burt discloses all of the limitations, except Burt does not teach the holding device specifically claimed in 6-8 and 11. The Examiner asserts, in part, that Marino discloses a

holding apparatus and therefore the combination of Burt and Marino teach all of the claimed elements of claims 6-8 and 11. (Action page 7) Further, regarding claims 9 and 10, the Examiner asserts, in part, that Burt discloses all of the limitations, except Burt does not teach the projections which extend into the interior of the holes. However, the Examiner asserts that Burt teaches projections provided at the cap/lid contacting side of the holding means, and it would have been obvious to one having ordinary skill in the art to provide the same idea to the vessel holding side.

Applicants respectfully traverse the rejections. As discussed above, Applicants assert that Burt does not disclose each and every limitation of the instant invention, specifically that the device as presently claimed can open and close the lid of the reaction vessel. Marino discloses a holding apparatus, but does not teach or suggest any means for the opening and closing of reaction vessels; therefore Marino does not provide the missing element of opening and closing the lid of the reaction vessel. Therefore the combination of Burt and Marino does not teach all of the elements of claim 1 and its dependents.

Further, it is not clear from the teachings of Burt and Marino that the sample tube holder of Marino would function with the device as taught by Burt; the Examiner has not provided any suggestion within Burt or Marino for this combination. As discussed above, Burt provides a device comprising a means for "knocking out any cap remaining in the hollow", and Marino teaches a solid rack with a plurality of openings. There is no space in between the openings in Marino's rack for a cap to be knocked out as described in Burt's device.

The Examiner has rejected claims 9 and 10 under § 103(a) as being unpatentable over Burt et al. in view of Marino and further in view of Hansen. (Action page 8) The Examiner asserts, in part, that Burt discloses all of the limitations as set forth above, except Burt does not explicitly show the projections provided at the holes of plates. Further the Examiner asserts, in part, that Hansen discloses a holding apparatus similar to the one disclosed by Marino which

teaches projections on the exterior of the tubes, and it would have been obvious to one skilled in the art to modify the invention of Burt to incorporate projections as taught by Hansen.

Applicants respectfully traverse the rejections. Again, as discussed above, Applicants assert that the combination of Burt and Marino does not disclose each and every limitation of the instant invention, specifically that the device as presently claimed can open and close the lid of the reaction vessel. The addition of Hansen does not provide this missing limitation. As with Marino, Hansen does not teach or suggest any means for the opening and closing of reaction vessels; therefore Hansen does not provide the missing element of opening and closing the lid of the reaction vessel.

In regards to the projections of claims 9 and 10, Applicants respectfully traverse the rejections. Applicants assert that neither Burt, Marino or Hansen individually or in combination teach the plurality of projections as provided in instant claims 9 and 10. Burt teaches projections on the cap/holding means; Burt does not teach projections in the interior of the openings on the plate of the reaction vessel holding device as required by the instant invention. The Examiner has not provided any specific teachings by Marino regarding these projections. Hansen provides, for example in Fig 5, an opening in the tube rack with a "jagged edge" designed to mesh with the exterior of the reaction vessels, designed to prevent tubes from falling out of the rack. (Hansen [0042]) In contrast, the instant invention provides specifically defined projections in each of the openings:

[0019] In a preferred embodiment, each of the openings of the middle perforated plate contains a projection which extends into the interior of the opening and is located roughly in the section area between a centre line of the opening concerned running in the direction of sliding, and the edge of the opening. When the reaction vessels are clamped in the perforated plates, this projection is pressed against the wall of the perforated plate, thereby effecting a positive holding of the reaction vessels.

[0020] Preferably each opening of the top and/or bottom perforated plates contains corresponding projections which are arranged diametrically opposite to the projection of the middle perforated plate. This enhances the engagement by which the reaction vessels are held in the perforated plates.

Hansen does not teach the use of projections that are specifically defined as provided in the instant invention. Further, the rack of Hansen requires the use of a specific reaction tube that has multiple "ridges" (see 146) that interlock with the opening in the rack (see 144) as shown in Hansen Fig 5; a reaction vessel with a smooth surface would not function in the design of Hansen. In contrast, the instant invention does not have a limitation to a certain reaction vessel design, and does not require a plurality of projections on the reaction vessel itself. Therefore, one skilled in the art would not be motivated to use the projections of Hansen with the device of Burt, primarily because the "tubes" or "containers" of Burt (the capped beer bottles) have a smooth outer surface and do not have projections on them, therefore they would not engage with the projections of Hansen (144) and therefore would not be held in place.

Applicants assert that the combination of Burt and Marino, further in view of Hansen, does not teach all of the elements of claim 1 and its dependents. Further, the Examiner has not demonstrated any motivation or suggestion in the art to combine Burt with Marino and Hansen.

Applicants assert that the Examiner has not established a *prima facie* case of obviousness. Applicants respectfully request the reconsideration and withdrawal of all of the §103 rejections.

CONCLUSION

Applicants respectfully request entry of the present amendments and remarks. In view of the above, Applicants believe all claims now pending in this Application are in condition for allowance. If the Examiner believes that a telephone conference would expedite prosecution of this application, please telephone the undersigned at **925-730-8566**.

Applicants respectfully request a 2-month extension of time to respond to the Office Action notification date April 16, 2010. The response date was July 16, 2010; with the granting of this request, the response time is re-set to September 16, 2010. The commissioner is hereby authorized to charge the amount of \$490, the fee due under 37 CFR §1.17(a)(2) to Deposit Account No. 50-0812. Please grant any additional extensions of time that may be required to enter this response and charge any additional fees or credit any overpayments to Deposit Account No. 50-0812.

Respectfully submitted,

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